

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB INC., AND
TV MANAGEMENT, INC., D/B/A GPS NORTH AMERICA,
Petitioners,

v.

PERDIEMCO LLC,
Patent Owner.

Cases¹

IPR2016-01061 (Patent 8,223,012 B1)
IPR2016-01062 (Patent 8,493,207 B2)
IPR2016-01063 (Patent 8,717,166 B2)
IPR2016-01064 (Patent 9,003,499 B2)

Before WILLIAM V. SAINDON, CARL M. DEFRANCO, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motions to Terminate
37 C.F.R. §§ 42.71(a), 42.72

¹ This Order addresses issues that are substantially similar in the cases. We exercise our discretion to issue one order to be filed in each case.

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I. INTRODUCTION

Petitions for these proceedings were filed on May 19, 2016 (Paper 5),² and a Notice of Filing Date was issued on June 7, 2016 (Paper 7). Patent Owner (PerDiem Co., LLC) filed Preliminary Responses in three of the proceedings on September 7, 2016. IPR2016-01061 (Paper 15); IPR2016-01063 (Paper 14); IPR2016-01064 (Paper 14). Patent Owner did not file a response in IPR2016-01062. On October 25, 2016, as authorized by the Board, Patent Owner filed a Motion To Terminate for Failure To List SkyBitz Inc. as a Real Party in Interest (“RPI”) in these four proceedings. Paper 17 (“Mot.” or “Motion”). Trial was instituted in IPR2016-01061 on December 6 (Paper 21); in IPR2016-01062 on December 6 (Paper 19); in IPR2016-01063 on November 29, 2016 (Paper 20); and in IPR2016-01064 on December 5, 2016 (Paper 20).

Petitioners³ have challenged a related patent, U.S. Patent No. 9,071,931 B2, in their petition for IPR2016-01278, which was filed on July 1, 2016 (IPR2016-01278, Paper 5), and Patent Owner filed its Preliminary

² Unless otherwise indicated, paper numbers refer to IPR2016-01061.

³ The petitions in the proceedings at issue here originally named as Petitioners Teletrac Inc., Navman Wireless North America, Ltd., Geotab Inc., and TV Management, Inc., d/b/a GPS North America. Paper 5. On August 15, 2016, Petitioners Teletrac Inc. and Navman Wireless North America, Ltd., moved to terminate the proceedings with respect to themselves only. Paper 12. The Board granted that motion on August 24, 2016, leaving as Petitioners Geotab Inc. and TV Management, Inc., d/b/a GPS North America. Paper 14. Patent Owner has not challenged Geotab’s RPI status. A recently filed notice (Paper 20) indicates Geotab may also seek dismissal from these proceedings.

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Response on October 7, 2016 (IPR2016-01278, Paper 12). Patent Owner included in that response a request that the Board deny that petition on the same grounds as raised in Patent Owner's motions to terminate the four related, earlier-filed proceedings. IPR2016-01278, Paper 12 at 3, 16–19.⁴ With Board approval, Petitioner TV Management, Inc., d/b/a GPS North America ("GPSNA") filed a Reply on November 18, 2016. IPR2016-01278, Paper 19.

The petitions in each of the proceedings at issue here name, *inter alia*, GPSNA and Telular Corporation ("Telular") as real parties-in-interest.⁵ *See, e.g.*, Paper 5 at 3. Patent Owner's Motions to Terminate contend that an additional entity, SkyBitz Inc. ("SkyBitz"), is a real party-in-interest to these proceedings that should have been named in the petitions and, therefore, the petitions should be dismissed, and the proceedings terminated, for failure to name all real parties-in-interest. Mot. 1; *see* 35 U.S.C. § 312(a)(2) (requiring a petition to identify all real parties-in-interest). In particular, citing to deposition testimony of Todd Lewis (the former CEO of GPSNA and current Vice President of SkyBitz), Patent Owner states that "GPSNA

⁴ This Order disposes of Patent Owner's motions to terminate in the four identified proceedings. Our disposition of Patent Owner's arguments for denial of the petition for failure to name SkyBitz as an RPI raised in the related proceeding, IPR2016-01278, will be addressed in our forthcoming decision on institution in that matter. This Order previews that disposition, as Patent Owner's arguments in its Preliminary Response seeking denial of the petition in that proceeding on grounds of failure to name SkyBitz are substantively the same as presented in Patent Owner's motions to terminate.

⁵ The petitions identify several other real parties-in-interest relating to other petitioners not implicated by Patent Owner's present motions. Paper 5 at 3.

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has been wholly subsumed within SkyBitz and does not exist anymore as a defined corporate entity.” *Id.* and n.1 (citing Ex. 2007).

Petitioner GPSNA (herein, “Petitioner”) filed an opposition to Patent Owner’s Motion, asserting that SkyBitz is not a real party in interest. Paper 18 (“Opp.” or “Opposition”). In particular, Petitioner asserts that “SkyBitz has neither controlled nor funded” the petitions in these proceedings, and also asserts that named RPI Telular Corporation, who wholly owns SkyBitz, has funded and controlled these proceedings on behalf of GPSNA. Opp. 1 (citing Ex. 1011 ¶¶ 3, 4, 8); *see also* Ex. 1012. Petitioner further asserts “Telular did not name SkyBitz as an RPI because, absent permission from Telular, SkyBitz has no ability to take any legal action, participate in any legal action, or supply any funds in relation to legal action.” *Id.* (citing Ex. 1011 ¶ 10).

II. DISCUSSION

For the reasons discussed below, we find that SkyBitz is not a real party-in-interest and was, therefore, not required to be named as such by Petitioner. We deny Patent Owner’s motions to terminate.

A. Allocation of Burdens

As an initial matter, we agree with the Board’s explanation regarding the burden of production and the burden of proof set forth in *Galderama*. *See Galderama S.A. v. Allegan Industrie SAS*, IPR2014-01422, Paper 14, 5–7 (PTAB Mar. 5, 2015) (citations omitted). Specifically, where, as here, Petitioner’s statement related to RPI is facially accurate and not ambiguous, Patent Owner bears the burden to produce evidence to rebut that

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presumption; once so produced, Petitioner has the ultimate burden of demonstrating compliance with 35 U.S.C. § 312(a)(2). *See id.*; *see also Hughes Network Sys., LLC v. Cal. Inst. Tech.*, IPR2015-00059, Paper 42 at 11 (PTAB Apr. 21, 2016) (“[O]nce the Petitioner has represented what it believes to be a proper identification of the real parties-in-interest, Patent Owner has the burden of production in establishing that a real party-in-interest has not been named.”); *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*, IPR2014-00488, Paper 61 at 6–7 (PTAB May 22, 2015) (holding that a petitioner’s identification of RPIs is presumed accurate and patent owner must provide sufficient rebuttal evidence to “reasonably bring[] into question the accuracy of the petitioner’s indication”).

B. Real Party-in-Interest Considerations and Factors

Whether a non-identified party is a real party-in-interest to a proceeding is a highly fact-dependent question. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“Trial Practice Guide”) (citing *Taylor v. Sturgell*, 553 U.S. 880 (2008)). “Courts invoke the terms ‘real party-in-interest’ and ‘privy’ to describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion.” *Id.* There is no “bright line test” for the degree of a party’s participation in a proceeding necessary to qualify as a real party-in-interest. *Id.* The Supreme Court in *Taylor* sets forth a list of factors that might be relevant in a particular case. *Taylor*, 553 U.S. at 893–95. “A common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” Trial Practice Guide, 77 Fed. Reg. at 48,759 (citing *Taylor*, 553 U.S. at 895). The

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